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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/050,775 | 01/18/2002 | Mitsuhiro Awaji | 001458.00016 | 9561 |

22907 7590 09/03/2003

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| EXAMINER |
|---|
| EDMONDSON, LYNNE RENEE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1725 | |

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/050,775 | AWAJI ET AL. | |
| | Examiner | Art Unit | |
| | Lynne Edmondson | 1725 | |

*-- Th MAILING DATE of this communication app ars on the cover sheet with the correspond nce address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 3 and 4 are objected to because of the following informalities: There appears to be a word or line missing in line 5 between the phrases "pinholes are brought into alignment," and "said wire or fiber or pin, and bonding". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagamine (JPN 07-230537 A).

Nagamine teaches an untapered pinhole disk laminate comprising multiple disks bonded and laminated such that the holes are superimposed (abstract). The disk thickness is controlled by the number of disks laminated. It is noted that a similar pinhole disk with similar properties can be fabricated by different methods (such as laminating and forming holes in a subsequent step). The disk is produced by

superposing multiple pinhole disks, allowing a light to pass through the center pinholes so that the hole positions are aligned and bonding (abstract and figure 4) with the holes kept in alignment. The light is received by a photo detector (abstract).

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ko et al. (JPN 11-317552 A)

Ko teaches an untapered pinhole disk laminate comprising multiple disks bonded and laminated such that the holes are superimposed (figure 3). The disk thickness is controlled by the number of disks laminated. It is noted that a similar pinhole disk with similar properties can be fabricated by different methods (such as laminating and forming holes in a subsequent step). The disk is produced by superposing multiple pinhole disks, allowing a wire to pass through the center pinholes so that the hole positions are aligned and bonding (with an adhesive) with the holes kept in alignment (abstract and paragraphs 8-11).

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Gotoh et al. (USPN 6449366 B1).

Gotoh teaches an untapered pinhole disk laminate comprising multiple disks bonded and laminated such that the holes are superimposed (figure 39A, col 9 line 18, col 10 lines 49-56 and col 36 line 58 – col 37 line 4). The disk thickness is controlled by the number of disks laminated. Column 36 lines 58-59 teach a two-layer disk. A three-layer disk would be thicker. It is noted that a similar pinhole disk with similar properties

can be fabricated by different methods (such as laminating and forming holes in a subsequent step). The disk is produced by superposing multiple pinhole disks, allowing light to pass through the center pinholes so that the hole positions are aligned (light penetrates the first and second layer through the same hole, col 36 lines 58-66) and bonding (col 10 lines 49-56) with the holes kept in alignment (col 37 lines 1-4). See also Gotoh claims 2 and 3.

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukuchi et al. (JPN 2001-047517 A).

Fukuchi teaches an untapered pinhole disk laminate comprising multiple disks (D) bonded and laminated such that the central holes are superimposed (figures 1A-2B). The disk thickness is controlled by the number of disks laminated. Figure 3C shows a two-layer disk. A three-layer disk would be thicker. It is noted that a similar pinhole disk with similar properties can be fabricated by different methods (such as laminating and forming holes in a subsequent step). The disk is produced by superposing multiple pinhole disks, allowing a pin to pass through the center pinholes so that the hole positions are aligned and bonding (with adhesive) with the holes kept in alignment (paragraphs 7-10, 14 and 17-19).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saitou et al. (JPN 63-049424 A, pin), Kikuchi (JPN 2001-35756 A, light) and Ishihara (USPN 5946100).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (703) 306-5699. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-3318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Lynne Edmondson
Examiner
Art Unit 1725

LRE